

REMARKS

The Examiner previously repeated and made final the rejection of claims 1-41 under 35 U.S.C. 102(b) as being anticipated by Malki et al., "Low Latency Handoff in Mobile IPv4, Internet Draft, pages 1-65, May 2001, hereafter referred to as Malki et al. A response to the final rejection was mailed on 06/24/2005, and an Advisory Action was mailed by the Examiner 07/06/2005. A telephone interview was held with the Examiner on 08/12/2005, but did not result in a resolution of this matter.

Appended hereto is a Supplemental Information Disclosure Statement making of record several publications. The Examiner is respectfully requested to consider and make these additional publications of record.

All of the previously made arguments regarding the use of the term "Bearer Context message" and the disclosure of Malki et al. are repeated and incorporated by reference herein.

The Examiner's argument appears to be that the only disputed matter is the term "Bearer Context message" in, for example, independent claim 1. In other words, the cited reference according to the Examiner discloses everything in independent claim 1 other than the term "Bearer Context message". The Examiner states that "[s]ince there is neither specific definition for the disputed term 'Bearer Context message' in the claim nor the specification of the instant application, Examiner, under strict guidelines of the MPEP, has given it a broadest reasonable interpretation consistent with the specification. In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000)." See Office Action dated May 17, 2005.

The Applicants previously responded by showing where in the specification the term "Bearer Context message" was defined.

In the Advisory Action dated 07/06/2005 the Examiner stated that "[t]here is no specific definition for the disputed term in the cited portion of the specification. The cited portion of the

specification clearly states 'what is referred to herein', not a definition. In accordance with 'Merriam Webster's Dictionary, Tenth Edition', 'refer to' means 'to think of, regard, or classify within a general category or group'. Thus contradistinction to the Applicants' allegation, there is neither specific definition for the disputed term 'Bearer Context message' in the claims nor the specification."

With reference to *In re Hyatt*, on page 1667, the court stated, "[t]hird, during examination proceedings, claims are given their broadest reasonable interpretation in light of consistent with the specification. That last proposition 'serves the public interest by reducing the possibility that claims, finally allowed, will be given broader scope than is justified,' and it is not unfair to applicants, because 'before a patent is granted the claims are readily amended as part of the examination process'". *Id.* at 1667 (citations omitted). In *Hyatt*, the issue presented was what the terms "shared" and "sharing" meant. *Hyatt* interpreted these terms one way (so that the claims did not read on the cited art) and the Board/Examiner interpreted them differently (so that the claims did read on the cited art). The court said that "[t]he specification, though lengthy, contains no definition of 'shared' or 'sharing' that would require the Board to construe those limitations in the narrower manner asserted by Mr. Hyatt. The Board's interpretation of those terms, although broad, is not unreasonable." *Id.* at 1668.

Although the Examiner does not mention this, *In re Hyatt* is cited at MPEP §2111 (May 2002).

It does not appear that a definition of a term need be prefaced by specific wording (such as "we define the term XXX to be the following", which is what the Examiner appears to be intimating), and no references in the MPEP could be found by the undersigned attorney that state such. In fact, the term "definition" as used in §2100 of the MPEP nowhere implies that one must use specific terminology when providing a "definition" of a term. It appears that the only criteria are that the claims are examined in light of the specification. For instance, according to MPEP §2111 (page 2100-47 of May 2004, Rev. 2 Edition), "The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach." (Citation omitted.) As another example, the "PTO applies to verbiage of the proposed

claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant's specification." Page 2100-47. See also the Section entitled "Plain Meaning" Refers to the Ordinary and Customary Meaning given to the Term by Those of Ordinary Skill in the Art, MPEP 2111.01 (II). See also MPEP 2111.01 (III) ("Where an explicit definition is provided by the applicant for a term, that definition will control interpretation of the term as it is used in the claim"; page 2100-50).

Furthermore, regardless of the interpretation of the term "Bearer Context message" in the claims, it does not appear that the cited reference discloses all elements of the claims. Independent claim 1 reads in part:

transmitting a Bearer Context message from the MN for use by the cellular network, the Bearer Context message comprising information for use in establishing at least one access bearer with the cellular network for an ongoing packet data session of the MN; and

responding to the receipt of the Bearer Context message with a Router Advertisement message that is forwarded towards the MN.

The only messages in FIG. 1 of Malki that are transmitted from the MN are the ProxyRtSol and the RegReq messages. Neither of these messages appears to comprise "information for use in establishing at least one access bearer with the cellular network for an ongoing packet data session of the MN" as recited in claim 1. It should be noted that on page 9 of Malki et al. it is said: "It should be noted that the methods described in this document may be applied to MNs having a single interface (e.g. Wireless WLAN interface) or multiple interfaces (e.g. two WLAN interfaces, one WLAN interface and one cellular interface). However, the case of the multiply-interfaced MNs needs special consideration, since the handoff methods described in this document may not be required in all cases (see Appendix B)." The highlighted text implies that the methods of the document may not be necessary in multiply-interfaced MNs. In Appendix B, it states, "the techniques discussed in this draft may be unnecessary if the Mobile IP stack on the

MN allows switching an IP address binding between interfaces. This Appendix discusses how multiple wireless interfaces can aid low latency handoff." Page 63. Appendix B does not state whether WLAN to cellular phone system handoff does or does not require the low latency methods described in Malki.

In any event, the claims have been amended above to remove the phrase "Bearer Context", and to also make it even more clear that this message "for use in establishing at least one access bearer with the cellular network for an ongoing packet data session of the MN" is sent to or via the WLAN. Other minor clarifications to the claim language were also made, and claim 26 was further clarified by the addition of claim 42. These amendments were not made for a reason related to patentability, and the full scope of equivalents for all of the elements of all of the claims should remain intact.

It is respectfully submitted that Malki et al. do not teach or suggest a message that is transmitted as claimed for use in for use in establishing at least one access bearer with the cellular network for an ongoing packet data session of a mobile node, or that any piggy-backing of any messages in Malki et al. is equivalent to the claimed subject matter of, for example, claim 2. As was previously noted, page 23, first paragraph of Malki et al. states only that:

"Piggy-backing advertisements on L2 messaging involves utilizing the L2 messaging involved in L2 handoff to transmit the Router Advertisement from the nFA to the MN or oFA. When the first L2 handoff messages are exchanged, it may be possible to transmit a Router Advertisement piggybacked onto L2 messages. Alternatively, the L2 at oFA may cache nFA's advertisements and not need to receive Router Advertisements upon every L2 handoff initiation. Whether this technique is possible depends on the particulars of the L2 technology and is outside the scope of this document".

The Applicants thus again submit that Malki et al. also clearly do not anticipate claim 2, as the piggybacking of advertisements on L2 messaging is clearly not analogous to the claimed piggybacking of the message "comprising information for use in establishing at least one access

bearer with the cellular network for an ongoing packet data session of the MN" on another message.

Turning again to the Examiner's arguments concerning QoS, the Applicants again note that Malki et al. state in Appendix B that Quality of Service (QoS), cost, etc are out of their scope:

"Suppose MN enters the coverage area of RN2 and nFA and that it prefers connectivity to this network for reasons beyond the scope of this document (e.g. user preferences, cost, QoS available etc.)."

Malki et al. do not anticipate, for example, claim 3 which expressly states that: "the message comprises information expressive of a QoS requirement of at least one ongoing application of the MN".

That portion of Malki et al. cited by the Examiner is the only mention of QoS in Malki et al., and in fact teaches away from the claimed invention as it states:

"Suppose MN enters the coverage area of RN2 and nFA and that it prefers connectivity to this network for reasons beyond the scope of this document (e.g. user preferences, cost, QoS available etc.)."

Malki et al. thus also clearly do not anticipate claim 3, notwithstanding the Examiner's various assertions regarding there being "no unified standard for Quality of Service (QoS)", etc.

The Examiner is again respectfully reminded that it is well recognized that "to constitute an anticipation, all material elements recited in a claim must be found in one unit of prior art", *Ex Parte Gould*, BPAI, 6 USPQ 2d, 1680, 1682 (1987), citing with approval *In re Marshall*, 578 F.2d 301, 304, 198 USPQ 344, 346 (CCPA 1978). In the instant case it is clear that not all "material elements" of claims 1-26 are found in Malki et al., and thus that Malki et al. cannot anticipate these claims under 35 U.S.C. 102(b).

S.N.: 10/600,156
Art Unit: 2666

The foregoing arguments apply as well to system claims 27-32, and to computer program claims 33-37 and 38-41, at least for the reason that each refers to a message sent for use in establishing at least one access bearer with the cellular network for an ongoing packet data session of the MN.

The Examiner is respectfully requested to reconsider and remove the rejections of the claims under 35 U.S.C. 102(b) based on Malki et al., and to allow all of the pending claims 1-42. An early notification of the allowability of claims 1-42 is earnestly solicited.

Respectfully submitted:



Harry F. Smith

8/17/2005
Date

Reg. No.: 32,493

Customer No.: 29683

HARRINGTON & SMITH, LLP

4 Research Drive

Shelton, CT 06484-6212

Telephone: (203)925-9400 Facsimile: (203)944-0245

email: hsmith@hspatent.com

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. BOX 1450, Alexandria, VA 22313-1450.

8/17/2005
Date

Elaine F. Mann
Name of Person Making Deposit